

USSN: 09/746,617

Case No.: 54509US006

REMARKS

Claims 21-31 are pending in the present application. Claims 21-31 stand rejected. Claim 24 has been amended. New claims 37-41 have been added. Claims 21-31 and 37-41 are pending.

Examination and reconsideration of the application as amended is requested.

Support for new claims 37-41 can be found in the specification, for example, on page 5, lines 18-23, and in original claims 21 and 32-36.

§ 112 Rejections

Claims 21-31 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner points specifically to the term "adjacent" in Claim 21 as unduly vague and indefinite with respect to the believed fixed relationship which must exist between the pieces of veneer throughout the utilization of the formed structure in its intended work environment. Adjacent is a well known term with a dictionary meaning including near or close, especially adjoining. See, for example, the veneer assembly shown in Figure 1. Therefore, the term adjacent as recited claim 21 is not vague or indefinite.

Claim 24 has been amended to add in the word "to" after "bonded" in line 1. This amendment does not, and is not intended to, limit the original scope of claim 24.

In summary, Applicants submit the rejection of claims 21-31 under 35 U.S.C. § 112, second paragraph, has been overcome, and that the rejection should be withdrawn.

§ 103 Rejections

Claims 21-31 stand rejected under 35 U.S.C. § 103 as being unpatentable over WO 98/55280. The Examiner states that the reference discloses embodiments which are substantially an anticipation of at least maintaining a plurality of wood veneer substrates in a fixed relationship to each other. The Examiner goes on to state that the tape is capable of maintaining the wood veneer substrates in a fixed relationship to each other before and during a lamination process and is preferably cleanly removable from the substrates following the

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lamination process. The Examiner states that the reference teaches that the adhesive may be manipulated by changing the level of tack and the degree of crosslinking to yield a suitable adhesive composition exhibiting the required properties. Therefore, the Examiner states that it is within the skill of one on the art to permit a significant amount of adhesive to remain on the wood veneer substrate.

However, more than a mere adjustment of the tack and crosslinking level is necessary to achieve the present invention. It is not necessarily obvious to one of skill in the art to manipulate the adhesive in such a way that it remains on the veneer while the backing remains removable. In any case, there is no motivation to one of skill in the art to practice the assembly claimed in claims 21-31.

In order to present a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 21 recites removing said backing from said veneer assembly, and a substantial amount of said layer of adhesive remains on said veneer assembly and wherein said entire backing is removable in substantially one piece.

A reference must be considered in its entirety. The reference cited by the Examiner teaches that the adhesive is cleanly removable. In fact, the reference cited by the Examiner teaches that leaving adhesive on the veneer is undesirable. (See, e.g., page 2, line 26 - page 3, line 5 of the reference cited.)

The rejection of claim 21 under 35 U.S.C. § 103(a) as being unpatentable over WO 98/55280 is unwarranted and should be withdrawn.

Claims 22-31 each add additional limitations to claim 21. Claim 21 is patentable for the reasons given above. Thus, claims 22-31 should likewise be patentable.

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In view of the above, it is submitted that the application is in condition for allowance.
Reconsideration of the application is requested.

Respectfully submitted,

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Version With Markings to Show Changes Made

24. (Amended) The veneer assembly of claim 23, wherein said layer of adhesive is bonded to said first and second pieces of veneer with a first adhesive strength, wherein said layer of adhesive is bonded to the second major surface of said backing with a second adhesive strength, wherein the layer of adhesive includes a cohesive strength, and wherein after bonding said veneer assembly to a substrate with an application of either:

- i) 100 psi for 45 minutes at 68°F; or
- ii) 75 psi for 1 minute at 250°F,
- a) said cohesive strength is greater than said second adhesive strength; and
- b) said first adhesive strength is greater than said second adhesive strength.